

### **REMARKS**

The following comments are responsive to the Office Action mailed January 14, 2009 (“Action”). Reconsideration and allowance are respectfully requested based on the following remarks.

#### **Rejections under 35 U.S.C. § 103(a)**

Claims 1-18, 20, and 22-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergsten et al (2003/0001907) and Hoarty et al (5485197). Applicants respectfully traverse for at least the following reasons.

##### **1. Comments on Claim 1**

The Action has improperly taken Official Notice to finally reject claim 1. As explained in M.P.E.P. § 2144.03, “[w]hile ‘official notice’ may be relied on, these circumstances **should be rare** when an application is under final rejection.” Emphasis added. The M.P.E.P. further explains that “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” *Id.* The rejection of claim 1 certainly is not based on facts that are “well-known” or are of “common knowledge in the art.”

The Action first errs by taking Official Notice when this application is under a final rejection. The M.P.E.P. explains that Official notice should **rarely** be relied on when an application is under final rejection. The Action does not explain why this final rejection falls into the rare category where Official Notice is appropriate in a final rejection. Official Notice is not appropriate for this case. Notably, the Action proceeds through nearly a page of text

explaining how it is “very possible” to meet the features of the claimed carousel not disclosed by the cited combination (*see* Action, p. 3-4), but in no way demonstrates that the missing claim elements are “well-known” or are of “common knowledge in the art.”

The Action next errs by relying on hindsight reasoning and taking Official Notice of the missing claim features as a basis for doing so. To reject claim 1, the Action concedes that all of the cited references, namely Bergsten and Hoarty, fail to teach or suggest the claim feature of “wherein the carousel extends beyond a perimeter of the display region.” *See* Action, p. 3. Thus, the Action admits that the cited combination cannot be used to support a *prima facie* case of obviousness under 35 U.S.C. § 103.

To overcome this deficiency in the cited combination, the Action states that the:

Examiner takes Official Notice that it is very possible to have the extension be horizontally or vertically beyond the perimeter of the display region, as long as the subset of the plurality of elements of the first sequential folder located on one side of the perimeter of the display region are displayed.

*See* Action, p. 3. Thus, the examiner alleges that it is very possible to modify Hoarty in the manner claimed.

Such analysis is blatantly hindsight and improper use of Official Notice. The standard discussed above for taking official notice is of facts that are “well-known” or are of “common knowledge in the art.” In no way is the Action asserting that the missing claim features are well-known or common knowledge, but rather the Action is looking at the claimed invention, and then modifying Hoarty based on the claimed invention because it is allegedly very possible to do

so. This is classic hindsight analysis. The Action is not considering the art at the time of the claimed invention, but rather is impermissibly relying on the claimed invention to overcome deficiencies in the cited references and improperly using Official Notice as a basis for doing so.

Moreover, the Action's justification for modifying Hoarty does not somehow indicate that the missing claim features are "well-known" or of "common knowledge in the art" to justify use of Official Notice. The Action alleges that Hoarty is accomplishing the same effect as the claimed "carousel extend[ing] beyond a perimeter of the display region," potentially in an attempt to indicate that the features of the claimed carousel are "well-known" or are of "common knowledge in the art." The Action alleges that:

because given that the subset of the plurality of elements of the first sequential folder located on one side of the perimeter of the display region are displayed, this still gives the virtual impression of rotating in three dimensions, *while still only physically displaying those elements that are currently in the perimeter of the display region.* Thus Hoarty et al is accomplishing the same effect with the same functionality as the claimed feature.

See Action, p. 3-4. The Action appears to be arguing that because the claimed carousel only "physically display[s] those elements that are currently in the perimeter of the display," and because Hoarty's carousel is effectively doing the same thing, that this reasoning somehow suggests that the missing claim features are "well-known" or of "common knowledge in the art." Applicants respectfully disagree.

Whether Hoarty accomplishes "the same effect with the same functionality as the claimed feature" is immaterial. The U.S. Patent & Trademark Office has granted thousands of patents to

different inventions that accomplish the same effect with the same functionality. Vacuum cleaners, for instance, accomplish the same effect, namely a clean floor, using the same functionality, namely suction. In no way does this preclude a patent from being issued on ways of accomplishing the same effect with the same functionality, so long as they are novel and non-obvious. Claim 1 is both novel and non-obvious over Hoarty, alone or in combination with Bergsten.

The carousel in Hoarty does not teach or suggest the carousel recited in claim 1. Below is figure 2d from the instant application depicting an example carousel followed by figure 35 depicting a carousel of Hoarty.

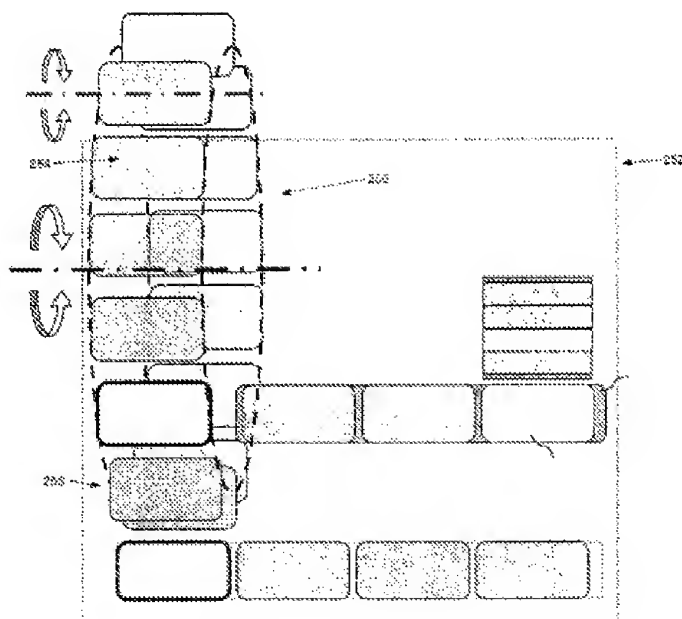
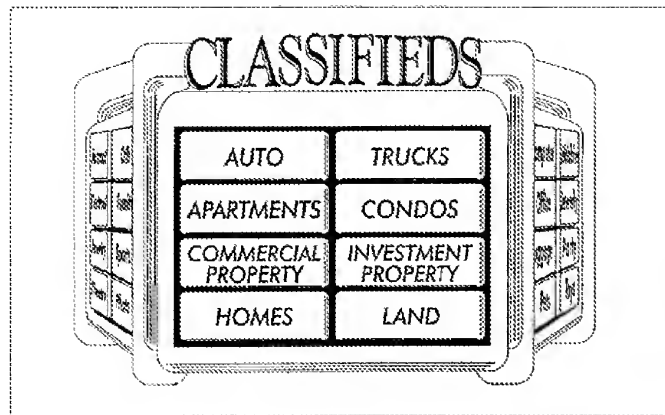


Figure 2D



**Fig. 35**

Plainly, the carousel in Fig. 35 of Hoarty does not extend “beyond a perimeter of the display region,” in contrast with carousel 250 in Fig. 2D of the instant application that extends beyond perimeter 252. As such, Applicants submit that taking Official Notice is improper as the facts officially noticed are not common knowledge or well-known, and hence the combination of Bergsten and Hoarty, even if proper, does not teach or suggest all of the features recited in claim 1 to establish a *prima facie* case of obviousness. Thus, Applicants respectfully submit that the rejection of claim 1 under 35 U.S.C. § 103(a) is improper and respectfully request that the rejection be withdrawn.

Should the Action disagree and believe that taking Official Notice is proper, Applicants respectfully request that the Office provide a reference along with the Advisory Action showing the allegedly well-known claim features admitted to be missing from Bergsten and Hoarty. See M.P.E.P. 2144, § C (“If applicant adequately traverses the examiner’s assertion of official notice, the **examiner must provide documentary evidence** in the next Office action if the rejection is to be maintained”)(emphasis added).

2. Comments on Claims 8-9, 28-29, and 37-38

Applicants respectfully request that the Office further explain its comments on pages 5-6 rejecting these claims as the rejection deficiencies noted in the previous response have not been addressed.

3. Remaining pending claims

Applicants submit that the remaining pending claims are allowable for at least some of the reasons set forth above, in addition to the features they recite.

**CONCLUSION**

All rejections having been addressed, applicant respectfully submits that this application is in condition for allowance, and respectfully requests issuance of a notice of allowance. If the Examiner believes that additional discussion and/or amendment would be helpful, the Examiner is invited to telephone Applicants' undersigned representative at the number appearing below.

Respectfully submitted,

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Dated: April 14, 2009

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